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IN THE

Supreme Court of the United States

October Term, 1968

No. 424

DRESSER INDUSTRIES, INC., a corporation,
Petitioner,

vs.

HERAEUS ENGELHARD VACUUM, INC.,
a corporation,
Respondent.

RESPONDENT'S BRIEF OPPOSING CERTIORARI

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Petitioner's "Genericness Issue"

The assertion that "Respondent stipulated at trial that to corporate purchasing agents Roots signified Petitioner," is challenged. No such stipulation was ever made.[1]

Respondent's Statement of Case

The Circuit Court of Appeals for the Third Circuit affirmed the decision of the District Court holding that in the fluid handling equipment field the designation "Roots" was descriptive of, and generic to, a specific type of lobe design pump (or compressor) or the engineering principle

[1] In a colloquy at trial (TR 527a-533a) counsel for respondent *offered* a stipulation that to *certain* purchasing agents who had been dealing and familiar with Roots-Connersville and Roots-Connersville products for a numb r of years, the word "Roots" identifies itself with Roots-Connersville (TR 533a). This offer was never accepted by petitioner (TR followed by a number or numbers indicates throughout this brief the transcript of proceedings and respective page number or numbers therein).

involved in its operation; that consequently this designation was *publici juris,* and that, as to such pump, petitioner had no rights of trademark therein (District Court Opinion, pages A-10, A-18-20, A-22, and Circuit Court of Appeals Opinion, pages B-9 and B-15).[2]

Petitioner assigns four reasons why a writ of certiorari should be granted (Petition, pages 8-9). These are in effect:

(1) The Circuit Court of Appeals held the controlling decision in the instant case to be that of this Court in Singer Mfg. Co. v. June Mfg. Co., 163 U. S. 169 (1896) and applied *Singer* without proof of genericness of the designation "Roors" during the patent term, in direct conflict with the requirements of the Singer doctrine.

(2) That this Court settle the question: "Should the patent-expired genericness aspect of *Singer* be overruled?"

(3) That this Court settle the question: "Whether a trademark can to the same buyers simultaneously be a valid trademark for certain products and a generic term as to another related product."

(4) That this Court settle the question: Whether in the determination of the genericness of a mark, the "relevant purchasing public" encompasses "all buyers of all products sold under the mark instead of only those persons who buy the single product with respect to which defendant has been alleged to infringe."

As to (1), *Singer* was not a controlling decision; to the extent it was applied, genericness during the patent monopoly was established as a *fact finding* by both lower

[2] A capital letter followed by a number or numbers indicates throughout this brief reference to the corresponding Appendix and page number or numbers of the Petition for Certiorari.

Courts; and the Circuit Court's decision does not contravene the *Singer* decision of this Court.

(2) is a question—not a reason; furthermore it is subordinate to (1) and is resolved by the non-controlling aspect of *Singer* and the finding of genericness during the patent term by the lower Courts.

(3) and (4) are addressed to questions of fact, *i.e.* whether the circumstances of a given situation do or do not spell out genericness of a word as a fact and as to which, once established, the applicable law is unequivocal.

All of petitioner's reasons are merely assertions for which petitioner contended unsuccessfully before the District Court and the Circuit Court of Appeals. None of them can support the granting of a writ of certiorari.

ARGUMENT

Petitioner's Reasons (1) and (2) Cannot Support the Petition for a Writ of Certiorari

With respect to reasons (1) and (2) petitioner contends that the District Court and the Circuit Court of Appeals "found *Singer* controlling" but applied the same without proof of genericness as called for by the *Singer* doctrine (Petition, pages 10-12). This is in error.

The District Court found as a fact, and *without any reference to any Roots patent, i.e.* solely on the basis of the meaning of the word Roots to the purchasing public (A-12-A-19) and as used by petitioner itself (A-18, A-19, A-20) that "the word Roots is generic" (A-10), that it "means, to buyers in the air and gas handling fields, an engineering principle or equipment designed in accordance with that principle" (A-18), that "The documentary

evidence demonstrates that the word Roots has been used for many years to describe this type of pump and its underlying principle" (A-19) and "that Roots, when used in the context of fluid handling equipment, is a term of generic significance" (A-20).

Based on these findings the District Court reached the following conclusion of law (A-22):

> "The word 'Roots' in designation of pumps, blowers, compressors, or the like, incorporating the design or principle referred to in Patent No. 2369[8] is in the public domain, and the plaintiff does not have any rights of *trade mark* or of *trade name* in said word *per se.*"

The Court of Appeals accepted the District Court findings as "amply supported by the evidence" (B-9) and expressed itself "wholly in accord with the District Court's conclusion" (B-11).

These findings and this conclusion are *per se* completely dispositive of this case without regard to any patent or the application of the *Singer* doctrine. *Del. & Huds. Canal Co. v. Clark,* 80 U. S. 311, 313, 20 L. Ed. 581, 583; *Goodyear's India Rubber Glove Mfg. Co. v. Goodyear Rubber Co.,* 128 U. S. 598, 600; 32 L. Ed. 535, 537; *Brown Chemical Co. v. Meyer,* 139 U. S. 540, 542, 35 L. Ed. 247; *Elgin National Watch Co. v. Illinois Watch Case Co.,* 179 U. S. 665, 674, 45 L. Ed. 365, 379, 380; *Howe Scale Co. v. Wyckoff,* 198 U. S. 113, 134, 135, 49 L. Ed. 972, 984; *Standard Paint Co. v. Trinidad Asphalt Mfg. Co.,* 220 U. S. 445, 461, 55 L. Ed. 536, 543; *Thaddeus Davids Co. v. Davids,* 233 U. S. 461, 58 L. Ed. 1046, 1048; *Estate of P. D. Beckwith v. Commissioner of Patents,* 252 U. S. 538, 544, 64 L. Ed. 705, 707; *Armstrong*

[8] The patent is used here merely in identification of the involved type of equipments.

Paint & V. Works v. Nu Enamel Corp., 305 U. S. 313, 335, 336, 83 L. Ed. 195, 206, 207.

Petitioner contends that the alleged application of the *Singer* doctrine is spelled out by a quoted portion of the lower Court's decision (Petition, page 10). The very quotation refutes this contention, however, as it specifically refers to the application of the *Singer* case *as well as* to the application of statutory law, which necessarily means Section 5 of the 1905 Trade Mark Act and Section 2(e) of the 1946 Lanham Act (15 U. S. C. 1052),[4] each of which bars a surname, including firm name, or generic or descriptive words from being effectively appropriated as a trademark.

Petitioner further argues that the same quotation shows that the District Court applied the *Singer* doctrine without establishing genericness during the patent term. The *complete* statement belies this argument and is as follows (A-21):

> "Thus Telechron and Enders Razor[5] . . . are insufficient, on their facts, to dissuade this Court from finding, upon the evidence in this case, that Roots *is a word of generic significance, merely descriptive of a type of vacuum pump and its underlying principle.* The word Roots *in this context* is incapable, under the Singer doctrine and under statutory law, of registration as a trademark" (emphasis ours).

Applying the *Singer* doctrine *"in this context"* necessarily refers to the next preceding sentence and thus means that the District Court *found* from the evidence *as a fact* genericness to have existed during the term of the Roots patent monopoly (asserted to have expired in 1874, Peti-

[4] See Respondent's Appendix.

[5] Telechron Inc. v. Telicon Corp., 97 F. Sup. 131, affd. 198 F. 2d 903; Enders Razor Co. v. Christy Co., 85 F. 2d 195.

tion pages 4-12). On this issue the Court of Appeals *found* (B-10):

> "The weight to be given the evidence of this nature in the case was for the district court and its findings adequately answer the question of fact raised by the plaintiff whether 'Roots' had become of generic significance during the term of the patent."

Furthermore, petitioner's contention that the Roots patent monopoly expired with the original Root patent in 1874, and that therefore all evidence on genericness must be pre-1874, is not well taken. The *Singer* case (p. 179 thereof) specifically involved a patent monopoly extending through the period of several patents "some of which were fundamental, some merely accessory," the test being "that during the life of the patents none of the machines as a whole were open to public competition." The record shows that this state of monopoly for the Roots design existed at least as late as 1895 (PX 19, item 2, p. 3) and it is the effect of this monopoly against which the *Singer* doctrine must be applied[6]

Assuming *arguendo* that there was no proof of the genericness of the name Roots during the term of the Roots patent monopoly (which is denied), such genericness is overwhelmingly established and was so found by the Court in the succeeding period up to the date of trial and beyond. It is then completely *immaterial to the outcome of this case* whether or not the two lower Courts, in applying the *Singer* doctrine to the patent monopoly, did so erroneously. What counts is that they applied the correct conclusions of law to the uncontrovertible findings of genericness in the 70-year post-monopoly period. Having this very point in mind the Court of Appeals stated (B-10, B-11):

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[6] On some of the supporting evidence of respondent's (defendant's below) see exhibits "P", "BB" and "DD" and TR 361a-363a.

> "The nub of the issue is whether a name still indicates exclusively the source or origin of manufacture of goods, not when, in point of time, a designation comes to be generally understood as generic or descriptive. Accordingly, we conclude that whether 'Roots' became a generic designation during the term of the patent or thereafter does not affect the application of the rule of the Singer decision to the facts of this case. It is the ultimate fact which is decisive—namely, it has in fact become a generic designation."

Thus *Singer* was not applied dispositive of the instant case and the extent of its application by the lower Courts was not in conflict with the *Singer* doctrine. Accordingly, petitioner's reasons (1) and (2) cannot support the petition for a writ of certiorari.

Petitioner's Reasons (3) and (4) Cannot Support the Petition for Writ of Certiorari

Petitioner wishes this Court to believe in effect (reason 3) that once a name or word has been applied to a variety of related products, it cannot, *as a matter of law,* be generic as to one such product (Petition, pages 12-14). This is an obvious fallacy.

Petitioner's assertion implies that by applying a mark which is non-descriptive for one product to another related product for which it is truly descriptive, the non-descriptiveness of the first application extends, by operation of law, to the second use, regardless of the descriptive nature of the mark for the second product. Alternatively, under petitioner's theory, a word truly descriptive of one product could be converted to an undefeatable trademark right by the simple expedient of also using the descriptive word on goods for which it is not descriptive. Both propositions are untenable and would be tantamount to recognizing the right to a trademark "in gross", i.e. the right to a word

apart from goods or trade as an abstract or independent property right. American trademark law does not recognize a trademark "in gross", Looz Inc. v. Ormont, 114 F. Supp. 211 (D.C. S.D. Cal.).

Genericness or descriptiveness are matters of fact and once found as a fact with respect to a specific product, must defeat a right of trademark. The Court of Appeals below properly so held, stating (B-5):

> "How a particular word has been used and how it has been understood by the public or the trade is a question of fact. Telechron, Inc. v. Telicon Corp., 3 Cir. 1952, 198 F. 2d 903, 907."

It was on the basis of the *facts* found by the District Court and the Court of Appeals that both Courts held genericness with respect to a specific product to have been established, and that on the basis of this *finding* the word Roots as applying to a particular type of pump or compressor, could not be a valid trademark.

Petitioner relies heavily on the Telechron and Enders cases (*supra*). Both cases, however, are different on the facts, and a reading of both cases clearly shows that the facts were considered first and that *under the particular facts* it was held that descriptiveness was not spelled out. Pro contra, in the case at bar, the Court held on the *facts* that descriptiveness as to one of the products was spelled out. The same situation is true of the other decisions cited by petitioner on the multi-product use point.

Referring to the Telechron and Enders decisions the Court of Appeals below aptly stated (B-14):

> "We have no quarrel with the holding of those cases that an arbitrary name can hardly become generic as applied to all of a wide variety of products of a manufacturer. But this is not to say that such

> a name may not become generic as to one of those products. Indeed, as Judge Willson found from ample evidence, this is exactly what has happened here."

With respect to the "relevant purchasing public" test [Reason (4)], petitioner argues in effect that in a multiple products use situation, genericness of a name cannot be established as to one such product unless that generic meaning is known to the purchasers of all of the other products (Petition, pages 18-21). This is untenable on its face. It is again necessarily a matter of *fact finding*, depending upon the particular circumstances of each case.

Actually petitioner's argument goes to the contention "that the trial judge should have given more weight to the plaintiff's witnesses and experts as to the meaning of the word 'Roots' to the purchasing public and should have answered this question and the question of the likelihood of confusion in the way testified to by those witnesses" (B-8). Disposing of this contention the lower Appellate tribunal correctly held (B-14):

> "The fallacy of this argument is that it does not meet an important *finding of fact* supported by the evidence in this case, namely, that these products are not offered to a spectrum of purchasers but to a relatively small and selective market, each purchase being made with reflection and without haste. We conclude that the district court properly applied the test of the Bayer case.'"[7] (emphasis ours).

As is thus evident, petitioner's reasons (3) and (4) go to questions of fact finding of the lower Courts and cannot support the petition for certiorari.

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[7] Bayer Co. v. United Drug Co., 272 F. 505, 509.

Conclusion

Petitioner has not established any valid reason for the granting of a writ of certiorari and the petition should be denied.

Respectfully submitted,

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APPENDIX

Statutes Involved

The following statutes are involved in addition to those already listed in petitioner's "Appendix D":

ACT OF FEBRUARY 20, 1905 (AS AMENDED)

SEC. 5. USC, title 15, sec 85. *Trade-marks which may be registered.* That no mark by which the goods of the owner of the mark may be distinguished from other goods of the same class shall be refused registration as a trade-mark . . .

(b) . . . .

Provided, That no mark which consists merely in the name of an individual, firm, corporation, or association not written, printed, impressed, or woven in some particular or distinctive manner, or in association with a portrait of the individual, or merely in words or devices which are descriptive of the goods with which they are used, or of the character or quality of such goods, or merely a geographical name or term, shall be registered under the terms of this Act

Public Law 489, 79th Congress; Chapter 540, approved July 5, 1946; 60 Stat. 427

* * * * * * *

SEC. 2 (15 U.S.C. 1052). *Trademarks registrable on the principal register*

No trademark by which the goods of the applicant may be distinguished from the goods of the others shall be refused registration on the principal register on account of its nature unless it—

* * * * * * *

(e) consists of a mark which, (1) when applied to the goods of the applicant is merely descriptive or deceptively misdescriptive of them, or (2) when applied to the goods of the applicant is primarily geographically descriptive or deceptively misdescriptive of them, except as indications of regional origin may be registrable under section 4 hereof, or (3) is primarily merely a surname;